

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Frederick Schuessler, et al.	Group Art Unit:	2876
Serial No.:	09/827,466	Examiner:	Jared Fureman
Filed:	4/6/2001	Atty. Dkt. No.:	6000.000900
For:	Method And System For Processing And Using Information	Client Docket:	0968
		Confirmation No.:	6160

APPEAL BRIEF**Customer No.: 23720**

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit this Appeal Brief to the Board of Patent Appeals and Interferences in response to the Advisory Action dated February 26, 2007. The Notice of Appeal was filed on January 29, 2007.

Since the Notice of Appeal for the present invention was filed on January 29, 2007, the two-month date for filing this Appeal Brief is March 29, 2007. Since this Appeal Brief is being filed on or before March 29, 2007, it is timely filed.

Since there is no separate Petition for Extension of Time filed herewith, this paper is to be construed as also constituting a Petition for Extension of Time Under 37 CFR § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

The Commissioner is authorized to deduct a fee of \$500 from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/6000.000900. No other fee is believed to be due in connection with the filing of this document. However, should any fee under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to this document, the Commissioner is hereby authorized to deduct said fee from **Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/6000.000900.**

I. REAL PARTY IN INTEREST

The present application is owned by Symbol Technologies, Inc..

II. RELATED APPEALS AND INTERFERENCES

Applicants are not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF THE CLAIMS

Claims 1, 4-6, 9-11, 13, 14, 18-20, 23-25, 28-30, 32, 33, 37, 38, 116, 131 and 133-146 are pending in the application. Claims 131 and 133-136 are at issue in this appeal and they are attached as Appendix A. Claims 131 and 133 were rejected in the Final Office Action issued on October 12, 2006 as allegedly being unpatentable under 35 U.S.C. 103(a) over U.S. Patent No. 6,199,048 to Hudetz et al. (**Hudetz**). Claims 134-136 dependent on independent claim 131 were rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over **Hudetz** in view of U.S. Patent No. 5, 979,762 (**Bianco**). Claims 131 and 133-136 of the pending claims 1, 4-6, 9-11, 13, 14, 18-20, 23-25, 28-30, 32, 33, 37, 38, 116, 131 and 133-146 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In general, the present invention is directed to processing information and in particular information received from bar code scanners. The bar code scanners may read bar codes which are encoded with information corresponding to an externally assigned entity, preferably an Internet address. For example, such a bar code may be a web code that leads one to a particular website (e.g., an Internet portal) rather than different consumer or product websites setup for manufactures or service providers. See Applicant's Specification p.2, lines 1-11. A portal may permit consumers to access information at the remote locations using inexpensive computerized resources and systems that are widely available. The portal may provide a system which may be employed by companies to distribute error free bar-coded identifiers, which enable consumers to use pre-existing bar code readers and systems to access information, purchase items and obtain service and warranty data. See Applicant's Specification p.7, line 4 - p. 8, line 3. There is one independent claim at issue in the current appeal: claim 131.

Independent claim 131 is generally directed to a method comprising receiving bar codes selected by a group of users using bar code readers (1A-1N). The method of claim 131 further includes allowing the group of users to connect to an Internet portal (10) in response to receiving the bar codes (400) and permitting the group of users to communicate with each other through a common web page based on information encoded in each bar code (400) and based on destination information corresponding to the received bar codes, wherein the destination information is accessible from the Internet portal (10). Accordingly, embodiments of the present

invention may provide a system and method for accessing information resources related to consumer products. By way of example only, at least portions of the invention are described at p. 7, line 4 p. 10, line 6; p. 13, line 7 – p. 15, line 6; p. 30, lines 15 – 20, and p. 33, line 10 – p. 38, line 21; Figures 1-3.

The system operation and method of the present invention may be carried out by a portal, which has an interface that receives scanner information from a plurality of devices having bar code scanners by wireless communication. The portal may transmit information to the devices or systems coupled to such devices. The portal may also include a subscriber interface which interfaces with subscribers either via the Internet or through other network communications, and which receives information from the subscribers for passing along to the users of the devices. The portal may further comprise a processor that operates or supports operation of a server, controlling the flow of information and accessing a database wherein source and destination information received from the scanner interface. The portal may maintain a database of barcodes, where each of those bar codes is a unique bar code that is assigned or associated with a particular subscriber. The database may also contain some additional information about each subscriber. Once the bar code that is printed in various media such as news papers, catalogues, products and the like, is scanned by the bar code scanning device, it is transmitted to the processor, which looks it up in the database and determines the destination of the information, enabling the processor to communicate information to the subscriber via the subscriber interface. See Applicant's Specification p.8, line 19 - p. 10, line 6.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellants respectfully request that the Board review and overturn the three rejections present in this case. The following issues are presented on appeal in this case:

- (A) Whether claims 131 and 133 are obvious over *Hudetz* ?
- (B) Whether claims 134-136 are obvious over *Hudetz* in view of *Bianco* ?

VII. ARGUMENT

Applicants respectfully submit that the Examiner erred in rejecting claims 131 and 133-136 for reasons fully set forth below. Therefore, Applicants respectfully request that the rejection of claims 131 and 133 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hudetz*, claims 134-136 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hudetz* in view of *Bianco* be reversed.

(A) Claims 131 and 133 are not obvious over *Hudetz*

1. Legal Standard

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142.

Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Federal Circuit precedent makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, to establish a *prima facie* case of obviousness, the prior art reference (or references when

combined) must teach or suggest all the claim features. Additionally, the references must provide a motivation to combine in the manner suggested by the Examiner. Mere conclusory statements to combine are insufficient.

2. The Cited Reference Does Not Teach Each and Every Claim Feature

In the Final Office Action mailed on October 12, 2006, the Examiner has maintained the rejection of claims 131 and 133 under 35 U.S.C. § 103(a) over *Hudetz*. Applicants respectfully traverse the Examiner's rejection

Claim 131 is directed to a method that comprises receiving bar codes selected by a group of users using bar code readers. The method includes allowing the group of users to connect to an Internet portal in response to receiving the bar codes. The method further includes permitting the group of users to communicate with each other through a common web page based on information encoded in each bar code and based on destination information corresponding to the received bar codes, wherein the destination information is accessible from the Internet portal.

As noted, the Examiner rejects claim 131 in view of *Hudetz* for obviousness. *Hudetz* provides a tool that allows users to access information from a web-site associated with a bar code. For example, if a user wishes to obtain information about a soup product, the user can scan a bar code located on a soup can to get product information about that soup from a website. See *Hudetz* Abstract and col. 3, lines 15 –col. 4, line 31. Similarly, another user may scan the same bar code on a soup can and may receive information about the same soup from the same website. In this way, *Hudetz* describes techniques for individual users (who are wholly unaware of other users) to independently go to a web-site to obtain more information relating to a bar code that has been read.

In contrast, the claimed invention describes permitting a group of users to communicate with each other through a common web-page of an Internet portal based on information associated with bar codes. The Examiner acknowledges that *Hudetz* does not teach this feature. However, the Examiner asserts that this feature is in the knowledge of one skilled in the art and thus takes an Official Notice.

The Examiner's position is flawed for several reasons. First, to make a prima facie case of obviousness, there must be a motivation to combine. Here, there is absolutely no motivation. As noted, *Hudetz* describes a way for individual users to separately (without regard for any other user) obtain information about products associated with bar codes from the website. Once the user obtains his or her information from the website, the purpose of the *Hudetz* system is accomplished. There is thus no reason for users to communicate with other users in *Hudetz* because it is directed to simply allowing individual users to retrieve the desired information from the website. Accordingly, there is no motivation or even suggestion in *Hudetz* or elsewhere to allow a group of users to communicate with each other through a common web page. The Examiner has not pointed to a single reference for a motivation to combine in such a manner. Instead, the Examiner conclusorily states it would have been obvious to modify teachings of *Hudetz* to arrive at claimed invention. See Final Office Action at page 4. This conclusory motivation to combine, however, is clearly insufficient. For this reason alone, independent claim 131 is allowable.

Importantly, the Examiner has failed to cite even a single secondary reference suggesting that features of claim 131 are obvious. That is, with respect to claim 131, the Examiner takes "Official Notice" to make a case of obviousness. To the extent, the Examiner is relying on the

personal knowledge in the art, the Examiner has failed to supply an Affidavit to that effect. Because the Office cites no specific reference to support this “obviousness” assertion, the Applicants infer that the Examiner makes this assertion based on personal knowledge. However, no supporting affidavit and/or evidence have been made of record in accordance with 37 C.F.R. § 1.104(d)(2), which states (emphasis added):

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

In view of the aforementioned deficiencies, the Examiner’s obviousness rejection is erroneous.

The Examiner’s obviousness rejection is flawed for an additional reason because the Examiner has failed to disclose each and every claimed feature. For example, the Examiner has failed to establish that the prior art discloses the claimed feature of “permitting the group of users to communicate with each other through a common web page based on information encoded in each bar code and based on destination information corresponding to the received bar codes.” In fact, the Examiner admits that the “permitting” step of claim 131 is not disclosed in *Hudetz*. However, the Examiner argues that this feature was well known to those skilled in the art because chat rooms and message boards “permitted” a group of users to communicate with each other through a common web page. See Final Office Action at page 8. But the claim 131 does not refer simply to “permitting” users to communicate through a common webpage. Rather, the claim specifies permitting users to communicate through a common webpage based on selected information – specifically, based on (1) information encoded in each bar code and (2) destination

information corresponding to the received bar codes. The Examiner simply has failed to show that chat rooms and message boards permit a group of users to communicate with each other based on the above-specified information, as called for by claim 131. For this additional reason, the Examiner's obviousness rejection is flawed.

For one or more reasons presented above, independent claim 131 is allowable. Additionally, claims depending from independent claim 131, namely claims 133-136, are allowable for at least the same reasons. Therefore, rejection of claims 131 and dependent claims 133-136 should be reversed.

(B) Claims 134-136 are not obvious over *Hudetz* in view of *Bianco*

The Examiner relies on *Hudetz* and U.S. Patent No. 5, 979,762 (*Bianco*) to reject claims 134-136 dependent on independent claim 131, arguing that claims 134-136 are taught by the combination of these references. The Applicants respectfully disagree and note that for at least the aforementioned reasons indicated above in the context of claim 131, the cited references, either considered alone or in combination fail to make obvious the claimed features of claims 134-136.

The Examiner alleges that since *Hudetz* teaches connecting a user to an Internet portal, and *Bianco* teaches allowing access to the contents of the bar code depending on whether a bar code is encrypted. The Examiner then concludes that the two references can be combined to arrive at the claimed invention. The Examiner's rejection is flawed for several reasons.

First, the two references, when considered alone or in combination, fail to teach each and

every claimed feature, as is required to establish a *prima facie* case of obviousness. Plainly stated, claim 134 calls for allowing user access to the Internet Portal based on whether the bar code information is encoded. Even assuming, as alleged by the Examiner, that *Hudetz* teaches connecting to the Internet, and further assuming *Bianco* discloses allowing contents of the bar code to be read depending on whether the bar code itself is encrypted, such a combination does not result in the claimed combination. For example, simply because *Bianco* teaches that an unencrypted bar code can be accessed by a “standard” reader does not mean that a user is allowed to connect an Internet Portal, as called for by claim 134. Rather, as explained in *Bianco*, such disclosure simply means that an unencrypted bar code can be read by a standard reader (as opposed to a specialized reader). Similarly, just because *Bianco* teaches using a specialized reader to read encrypted bar codes does not mean that a user is denied access to the Internet Portal as called for by claim 134. Simply put, the encryption status of the bar code has nothing to do with whether a user is allowed access to the Internet Portal. At best, the encryption status simply describes which type of reader (standard or specialized) can access that bar code. *Hudetz* fails to cure this fundamental deficiency of *Bianco*. If anything, *Hudetz* teaches away from the claimed invention because it discloses allowing unfettered access to the ISP (“Internet Portal,” according to the Examiner), without regard for whether the bar code information is encrypted. Thus, contrary to the Examiner assertions, nothing in the cited references discloses allowing access to the Internet Portal based on whether the bar code information is encoded.

There is no teaching or suggestion in either *Hudetz* or *Bianco* to connect to the Internet portal when encryption of the bar code information is not indicated and not allowing the user to connect to the Internet portal when encryption of the bar code information is indicated. That is, a user is not selectively allowed to connect to the Internet portal depending on whether or not a

scanned bar code indicates if this bar code was encrypted. Accordingly the rejection of claim 134 as being obvious over *Hudetz* in view of *Bianco* is improper and should be withdrawn. Likewise, the claim 135 feature of connecting the user to the Internet portal depending upon whether the encryption of the bar code information is turned off is not rendered obvious in a *prima facie* manner by the cited references. Like *Hudetz*, *Bianco* also fails to supply this missing claimed feature. Thus, claims 135 are allowable for this additional reason. Dependent claim 136 is also allowable for at least the same reasons as claim 134. Therefore, rejection of claims 134-136 should be reversed.

VIII. CLAIMS APPENDIX

The claims that are the subject of the present appeal – claims 131 and 133-136 – are set forth in the attached “Claims Appendix.”

IX. EVIDENCE APPENDIX

Applicants do not rely upon any evidence as indicated on the attached Evidence Appendix.

X. RELATED PROCEEDINGS APPENDIX

There are no Related Proceedings for this appeal as indicated on the attached Related Proceedings Appendix.

XI. CONCLUSION

Accordingly, it is respectfully submitted that the Examiner erred in not allowing claims 131 and 133-136 over the prior art of record. Applicants respectfully request the Board reverse

the Examiner's rejections. The undersigned agent may be contacted at (713) 934-4089 with respect to any questions, comments or suggestions relating to this appeal.

Respectfully submitted,
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AGENT FOR APPLICANTS

CLAIMS APPENDIX

131. A method, comprising
receiving bar codes selected by a group of users using bar code readers;
allowing the group of users to connect to an Internet portal in response to receiving the bar codes;

permitting the group of users to communicate with each other through a common web page based on information encoded in each bar code and based on destination information corresponding to the received bar codes, wherein the destination information is accessible from the Internet portal.

133. The method according to claim 131, wherein receiving bar codes selected by a group of users further comprises:

receiving bar codes selected by a group of users using bar code readers each bar code associated with source information identifying a user of the bar code readers.

134. The method according to claim 131, wherein allowing the group of users to connect, further comprises:

allowing at least one user to connect to the Internet Portal when encryption of bar code information is not indicated and not allowing the user to connect to the Internet Portal when encryption of the bar code information is indicated.

135. The method according to claim 134, wherein allowing said at least one user to connect further comprises:

connecting said at least one user to a telephone number or the Internet Portal depending

upon whether the encryption of the bar code information is turned off.

136. The method according to claim 135, further comprising:

providing data received from the Internet portal to said at least one user of at least one of the bar code readers based on the received source information.


**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATES PATENT AND TRADEMARK OFFICE**

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